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***YANGTZE MEMORY TECHNOLOGIES, INC.***

**UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 SAN FRANCISCO DIVISION**

YANGTZE MEMORY TECHNOLOGIES  
 COMPANY, LTD.,

Plaintiff,

v.

MICRON TECHNOLOGY, INC., and  
 MICRON CONSUMER PRODUCTS  
 GROUP, LLC,

Defendants.

MICRON TECHNOLOGY, INC.,

Counterclaim Plaintiff,

v.

YANGTZE MEMORY TECHNOLOGIES  
 COMPANY, LTD., and YANGTZE  
 MEMORY TECHNOLOGIES, INC.,

Counterclaim Defendants.

Case No. 3:23-cv-05792-RFL

**COUNTERCLAIM DEFENDANTS' NOTICE  
 OF MOTION AND MOTION TO DISMISS  
 COUNTERCLAIMS PURSUANT TO  
 FEDERAL RULES OF CIVIL PROCEDURE  
 12(b)(6); MEMORANDUM OF POINTS AND  
 AUTHORITIES IN SUPPORT THEREOF**

Hearing Date: April 23, 2024

Time: 10:00 a.m.

Place: Courtroom 15

Judge: The Hon. Rita F. Lin

**NOTICE OF MOTION AND MOTION TO DISMISS**

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

NOTICE IS HEREBY GIVEN that Counterclaim Defendants Yangtze Memory Technologies Company, Ltd. (“YMTC”) and Yangtze Memory Technologies, Inc. (“YMTI”) respectfully move for an order dismissing the counterclaims filed by Micron Technology, Inc. (“Micron”) in Defendants’ Answer to First Amended Complaint and Counterclaims, ECF No. 35. The hearing on this Motion shall take place on April 23, 2024, at 10:00 a.m. in Courtroom 15 on the 18th Floor of the above-entitled Court located at 450 Golden Gate Avenue, San Francisco, CA 94102.

YMTC and YMTI respectfully request that the Court dismiss Micron’s counterclaims pursuant to Rule 12(b)(6) because Micron has failed to state a claim for relief as to every cause of action asserted in the counterclaims.

This motion is based upon this Notice, the accompanying Memorandum of Points and Authorities, and upon such other documentary and oral evidence or argument as may be presented at the hearing on this Motion.

Dated: March 12, 2023

ROPES & GRAY LLP

By:

/s/ Andrew T. Radsch

Andrew T. Radsch  
Attorney for Counterclaim Defendants  
YANGTZE MEMORY TECHNOLOGIES  
COMPANY, LTD. and YANGTZE MEMORY  
TECHNOLOGIES, INC.

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## MEMORANDUM OF POINTS AND AUTHORITIES

### INTRODUCTION

Before a “case should be permitted to go into its inevitably costly and protracted discovery phase,” “some threshold of plausibility must be crossed at the outset.” *Asahi Glass Co. v. Pentech Pharms., Inc.*, 289 F. Supp. 2d 986, 995 (N.D. Ill. 2003) (quoted by *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 558 (2007)). Micron’s counterclaims for patent infringement do not cross that threshold. As a result, they should be dismissed.

Micron’s counterclaims for direct infringement do not cross the threshold of plausibility. Direct patent infringement reaches only those activities occurring *in the United States*. To state a claim for infringement, Micron was required to plead sufficient facts demonstrating that it is plausible—not merely possible—that YMTC and YMTI make, use, sell, offer to sell, or import the Accused Products *in the United States*. Micron did not do so. Micron admits that the Accused Products are not made in the United States. And with respect to the other statutorily proscribed activities of using, selling, offering to sell, and importing, Micron’s counterclaims repeat the same conclusory allegation that parrots the elements of the cause of action. But the law is clear: that is not enough.

Where Micron does plead any facts—rather than only conclusions—those facts do not plausibly support a claim for direct infringement against YMTC or YMTI. For example, Micron alleges that it purchased, from third party e-commerce websites, third party products which allegedly incorporate an Accused Product. But those alleged facts do not plausibly (let alone possibly) establish that *YMTC* or *YMTI* sold the Accused Products in the United States, or even imported, offered to sell, or used them in the United States. As one of the world’s leading 3D NAND companies, if YMTC or its subsidiary, YMTI, had sold the Accused Products in the United States, presumably Micron would have cited evidence of that occurring. It did not. And that omission is telling. Because Micron has not sufficiently pleaded that YMTC or YMTI performed any infringing acts in the United States, Micron’s direct infringement claims under 35 U.S.C. § 271(a) and (g) should be dismissed.

1 Micron's claims for induced infringement also do not cross the threshold of plausibility, for  
2 two independent reasons. First, Micron does not plead facts showing that it is plausible that YMTC  
3 or YMTI had pre-filing knowledge of the Asserted Patents or the alleged infringement thereof. Rather,  
4 Micron pleads in only conclusory fashion that YMTC and YMTI knew of the Asserted Patents. And  
5 even then, Micron does not aver that either YMTC or YMTI knew of the alleged infringement by  
6 others of those patents. Moreover, where Micron does plead facts about YMTC's or YMTI's  
7 knowledge, those facts establish only that YMTC or YMTI knew of other Micron patents—not the  
8 Asserted Patents. Again, the law is clear: that is not enough.

9 Second, Micron fails to plead facts plausibly establishing that YMTC or YMTI in fact induced  
10 another to infringe. That is, Micron does not plead facts that plausibly establish that YMTC or YMTI  
11 possessed the required specific intent to induce infringement by another and took deliberate steps to  
12 encourage another to infringe. Again, each of Micron's patent infringement counterclaims recites only  
13 conclusory allegations about YMTC's or YMTI's active inducement of another. And where Micron  
14 does plead any facts, they fall far short of establishing a plausible claim. For example, Micron cites a  
15 general English-language YMTC webpage and the presence of YMTI employees in the United States,  
16 but Supreme Court and other precedent make clear that allegations about such generic commercial  
17 activities do not plausibly suggest wrongdoing. Accordingly, Micron's counterclaims of induced  
18 infringement under 35 U.S.C. § 271(b) must also be dismissed.

19 Independent of the foregoing shortcomings of Micron's counterclaims, Micron also does not  
20 plead that it has complied with the marking statute and, as such, has failed to state a claim for pre-  
21 filing damages (the only pre-filing remedy) as to four of the five Asserted Patents. This is an  
22 additional, independent reason to dismiss as to those four patents.

23 Finally, there can be no claim for willful infringement without a predicate claim for  
24 infringement. Because Micron's claims for direct and indirect infringement should be dismissed, so  
25 too should Micron's claims of willful infringement be dismissed.

26 YMTC and YMTI respectfully request that all of Micron's counterclaims in its Counterclaim  
27 Complaint (ECF No. 35) be dismissed under Rule 12(b)(6).  
28



## STATEMENT OF ISSUES TO BE DECIDED

1. Whether the Court should dismiss Micron’s claims for direct patent infringement under 35 U.S.C. § 271(a) where Micron has not pleaded with sufficiency that YMTC or YMTI has made, used, offered for sale, or sold the Accused Products within the United States, or imported the Accused Products into the United States.

2. Whether the Court should dismiss Micron’s claims for direct patent infringement under 35 U.S.C. § 271(g) where Micron has not pleaded with sufficiency that YMTC or YMTI has imported into the United States, or offered for sale, sold, or used within the United States, a product made by a process patented in the United States.

3. Whether the Court should dismiss Micron’s claims for inducement of patent infringement under 35 U.S.C. § 271(b) where Micron has not pleaded with sufficiency that YMTC or YMTI had the requisite knowledge, or that with specific intent to induce others to infringe, YMTC or YMTI took any active steps to encourage another to infringe.

4. Whether the Court should dismiss Micron’s counterclaims with respect to any alleged pre-filing infringement by YMTC or YMTI where Micron has failed to plead compliance with the marking statute, 35 U.S.C. § 287, and so cannot recover damages prior to its filing of the counterclaims, and where the Federal Circuit has held that dismissal of such claims is appropriate in such circumstances.

5. Whether the Court should dismiss Micron’s claims for willful patent infringement where Micron has not sufficiently pleaded a claim for infringement at all.

## RELEVANT FACTUAL ALLEGATIONS

YMTC is headquartered in China and maintains a principal place of business in Wuhan, China. *See* Defendants’ Answer to First Amended Complaint and Counterclaims, ECF No. 35, Counterclaims (¶¶ 1-83) (“Counterclaim Complaint”) at ¶ 13; YMTC’s First Amended Complaint for Patent Infringement, ECF No. 29 (“First Amended Complaint”), ¶ 12. YMTC is a manufacturer of 3D NAND technology in China. *Id.* YMTI is a wholly-owned subsidiary of YMTC. First Amended Complaint, ¶ 12; Counterclaim Complaint, ¶ 28. Micron does not allege that YMTC and YMTI are

1 mere alter egos such that their corporate separateness may be disregarded. And while Micron does  
 2 allege that YMTC and YMTI “commit[] the acts of infringement . . . together as one enterprise,” and  
 3 that YMTC controls YMTI, Micron alleges no facts in support of either allegation. *Id.*, ¶¶ 1, 28.

4 Micron alleges that YMTC and YMTI directly and indirectly infringe five patents.<sup>1</sup> *Id.*, ¶¶ 33-  
 5 83.

6 With respect to direct infringement under § 271(a), Micron repeats the same allegation for each  
 7 count of its counterclaims: “[t]he YMTC Entities infringe at least claim 1 of the [asserted] patent under  
 8 35 U.S.C. § 271(a), literally and/or under the doctrine of equivalents, by using, offering for sale,  
 9 selling, and/or importing into the United States, without authorization, the YMTC Accused Storage  
 10 Products.”<sup>2</sup> *Id.*, ¶¶ 36, 46, 57, 67, 77. Micron does not allege that YMTC or YMTI directly infringes  
 11 by making that Accused Products in the United States; rather, it avers that the Accused Products are  
 12 made “outside the United States,” *id.*, ¶ 47. Micron also does not allege sufficient facts in support of  
 13 its allegations that YMTC or YMTI has sold in the United States an Accused Product; offered for sale  
 14 in the United States an Accused Product; used an Accused Product in the United States; or imported  
 15 into the United States an Accused Product. Instead, Micron’s counterclaims cite alleged sales by third  
 16 parties Bigamart.com and Amazon.com of products produced by another third party, Lexar, which  
 17 products Micron alleges contain an Accused Product. *Id.*, ¶ 21 & Exs. 28-30. Micron does not, nor  
 18 could it, allege that Bigamart.com, Amazon.com, or Lexar are alter-egos or agents of YMTC or YMTI,  
 19 or otherwise allege that the alleged acts of Bigamart.com, Amazon.com, or Lexar can be attributed to  
 20 YMTC or YMTI.

21  
 22 <sup>1</sup> U.S. Patent Nos. 10,475,737 (the “’737 patent”), 8,945,996 (the “’996 patent”), 8,803,214 (the  
 23 “’214 patent”), 10,872,903 (the “’903 patent”), and 10,373,974 (the “’974 patent”), collectively  
 referred to herein as the “Asserted Patents.”

24 <sup>2</sup> Micron’s counterclaims define the “YMTC Accused Storage Products” as YMTC’s 64-layer 3D  
 25 NAND products, including the X1-9050 and X2-9060 products; 128-layer 3D NAND products,  
 26 including the X2-6070 product; and 232-layer 3D NAND products, including the X3-9060, X3-  
 27 9070, and X3-6070 products. *Id.*, ¶ 20. For simplicity, YMTC and YMTI use the phrase “Accused  
 28 Products” herein to refer to the YMTC Accused Storage Products.

1 As to the asserted '996 patent, which contains only method claims (directed to forming  
2 circuitry components or an array of memory cells), *id.*, Ex. 3 at 11:15-14:29, Micron also alleges that  
3 YMTC and YMTI directly infringe under § 271(g), *id.*, ¶ 47. Specifically, Micron alleges that “[t]he  
4 YMTC Entities infringe at least claim 1 of the '996 patent under 35 U.S.C. § 271(g), literally and/or  
5 under the doctrine of equivalents, by directly or indirectly importing into the United States the YMTC  
6 Accused Storage Products, which Products are made outside the United States using the patented  
7 process of at least claim 1 of the '996 patent, are not materially changed by subsequent processes, and  
8 are not a trivial and nonessential component of another product.” *Id.*, ¶ 47. As with its claims under  
9 § 271(a), Micron does not allege any facts in support of its allegations that YMTC or YMTI has  
10 imported into the United States an Accused Product. *See id.*

11 Micron also alleges that YMTC and YMTI induce infringement of each of the Asserted Patents  
12 under § 271(b). For each patent, Micron repeats the allegation that “[t]he YMTC Entities also actively  
13 induce infringement of at least claim 1 of the [asserted] patent under 35 U.S.C. § 271(b), and have  
14 done so since at least the filing of these counterclaims, by actively encouraging others to infringe (such  
15 infringement by others being by way of using, selling, offering to sell, or importing into the United  
16 States the YMTC Accused Storage Products).” *Id.*, ¶¶ 38, 49, 59, 69, 79. While Micron alleges that  
17 YMTC and YMTI knew of Micron’s patent portfolio generally, and that YMTC has been issued  
18 patents that cite certain Micron patents that are not the Asserted Patents, Micron does not allege facts  
19 showing that YMTC or YMTI knew of the specific Asserted Patents or of their alleged infringement  
20 thereof. Micron also does not allege that YMTC or YMTI induced any specific third party to allegedly  
21 infringe. With respect to its allegations of sales in the United States by third parties, Bigamart.com  
22 and Amazon.com, of another third party’s products (Lexar) that allegedly incorporate the Accused  
23 Products, Micron does not allege any particular relationship between YMTC or YMTI and any of  
24 Bigamart.com, Amazon.com, or Lexar; does not allege that YMTC or YMTI knew that those third  
25 parties allegedly were selling in the United States products that incorporate an Accused Product; and  
26 does not allege any facts that would support any of the foregoing allegations, even if made.

1 With respect to each Asserted Patent, Micron also alleges that, “[s]ince at least the filing of  
 2 these counterclaims, the YMTC Entities’ infringement has been willful.” *Id.*, ¶¶ 41, 52, 62, 72, 82.  
 3 Micron does not allege any facts in support of that allegation. *See id.*

4 Finally, Micron does not allege that it has complied with the marking provisions of the Patent  
 5 Act. *See generally* Counterclaim Complaint.

## 6 ARGUMENT

### 7 I. Legal Standards

#### 8 A. Motion to Dismiss Under Rule 12(b)(6)

9 To survive a motion to dismiss under Rule 12(b)(6), “a complaint must contain sufficient  
 10 factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v.*  
 11 *Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Twombly*, 550 U.S. at 570). “This ‘facial plausibility’  
 12 standard requires the plaintiff to allege facts that add up to ‘more than a sheer possibility that a  
 13 defendant has acted unlawfully.’” *Garrett v. TP-Link Research Am. Corp.*, No. 20-cv-03491-SI, 2020  
 14 WL 5517202, at \*2 (N.D. Cal., Sept. 14, 2020) (granting a motion to dismiss patent infringement  
 15 claims) (quoting *Iqbal*, 556 U.S. at 678). “While legal conclusions can provide the framework of a  
 16 complaint, they must be supported by factual allegations.” *Iqbal*, 556 U.S. at 679. Accordingly,  
 17 “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,  
 18 do not suffice.” *Id.* at 678; *see also Twombly*, 550 U.S. at 557.

19 “In reviewing a Rule 12(b)(6) motion, a district court must accept as true all facts alleged in  
 20 the complaint and draw all reasonable inferences in favor of the plaintiff.” *Garrett*, 2020 WL 5517202,  
 21 at \*2 (citation omitted). “However, a district court is not required to accept as true ‘allegations that  
 22 are merely conclusory, unwarranted deductions of fact, or unreasonable inferences.’” *Id.* (quoting *In*  
 23 *re Gilead Scis. Sec. Litig.*, 536 F.3d 1049, 1055 (9th Cir. 2008)).

#### 24 B. Patent Infringement and Remedies

25 Section 154 of the Patent Act prescribes that “[e]very patent shall contain ... a grant to the  
 26 patentee ... of the right to exclude others from making, using, offering for sale, or selling the invention  
 27 throughout the United States or importing the invention into the United States, and, if the invention is  
 28

a process, of the right to exclude others from using, offering for sale, or selling throughout the United States, or importing into the United States, products made by the process, referring to the specification for the particulars thereof.” 35 U.S.C. § 154(a)(1). Accordingly, “[i]t is the general rule under United States patent law that no infringement occurs when a patented product is made and sold in another country.” *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 437 (2007).

### **1. Direct Infringement Under § 271(a)**

Direct patent infringement under § 271(a) occurs only if a person, “without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent.” 35 U.S.C. § 271(a). “[T]he express language of . . . section 271(a)” does not “appl[y] to conduct outside the United States.” *See, e.g., Int’l Rectifier Corp. v. Samsung Elecs. Co.*, 361 F.3d 1355, 1360 (Fed. Cir. 2004).

### **2. Direct Infringement Under § 271(g)**

Under § 271(g), “[w]hoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer.” 35 U.S.C. § 271(g). As with infringement under § 271(a), infringement under § 271(g) applies only where the defendant has engaged in the proscribed conduct—using, selling, offering for sale, or importing—“within this country.” *Syngenta Crop Prot., LLC v. Willowood, LLC*, 944 F.3d 1344, 1364 (Fed. Cir. 2019) (“[defendant] did not import into the United States or sell or offer for sale in the United States the [accused product]... We therefore affirm the district court’s judgment that [Defendant] did not infringe the [asserted patent] under § 271(g).”)

### **3. Induced Infringement Under § 271(b)**

The Patent Act also provides that “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” 35 U.S.C. § 271(b).

A patentee asserting induced infringement under § 271(b) must show the following three elements: “(1) a third party directly infringed the asserted claims of the [asserted] patents; (2) [the accused infringer] induced those infringing acts; and (3) [the accused infringer] knew the acts it induced constituted infringement.” *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*,

843 F.3d 1315, 1332 (Fed. Cir. 2016); *accord Viavi Sols. Inc. v. Platinum Optics Tech. Inc.*, No. 5:21-cv-06655-EJD, 2023 WL 6795417, at \*4 (N.D. Cal., Oct. 13, 2023). This requires “the patentee [to] show that the accused inducer took an affirmative act to encourage infringement.” *Power Integrations*, 843 F.3d at 1332 (quoting *Astornet Techs. Inc. v. BAE Sys., Inc.*, 802 F.3d 1271, 1279 (Fed. Cir. 2015)). Specific intent is required. “For an allegation of induced infringement to survive a motion to dismiss, a complaint must plead facts plausibly showing that the accused infringer ‘specifically intended [another party] to infringe [the patent] and knew that the [other party]’s acts constituted infringement.” *Lifetime Indus. v. Trim-Lok, Inc.*, 869 F.3d 1372, 1379 (Fed. Cir. 2017) (quoting *In re Bill of Lading Transmission & Processing Sys. Pat. Litig.*, 681 F.3d 1323, 1339 (Fed. Cir. 2012)).

A claimant must plead that the accused infringer knew of the patent; “[m]ere knowledge of a ‘patent family’ or the plaintiff’s ‘patent portfolio’ is not enough.” *Sonos, Inc. v. Google LLC*, 591 F. Supp. 3d 638, 643 (N.D. Cal. 2022), *leave to appeal denied*, No. 2022-134, 2022 WL 1486359 (Fed. Cir. May 11, 2022). A claimant must plead that the accused infringer took affirmative acts to encourage another party to infringe the patent, *Power Integrations*, 843 F.3d at 1332; it is not enough to merely plead that the third party itself infringed, *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 904 (Fed. Cir. 2014) (“Absent the knowledge and affirmative act of encouragement, no party could be charged with inducement.”). And a claimant must plead that the accused infringer had the specific intent to cause infringement, and knew that the acts were infringing, *Lifetime Indus.*, 869 F.3d at 1379; it is not enough to plead that the accused infringer sold the accused products to a foreign third party who then sold them throughout the world, including in the U.S. *See Largan Precision Co. v. Genius Elec. Optical Co.*, 86 F. Supp. 3d 1105, 1118 (N.D. Cal. 2015); *Viavi Sols. Inc.*, 2023 WL 6795417, at \*4 (describing *Largan* as holding that “even if [defendant] did induce [customers] Apple and Motorola to use its filters, it would still lack the requisite knowledge that the included [*sic*] acts constituted infringement because the products could be sold outside the U.S., i.e., not infringe the asserted patents.”).

#### 4. Marking Requirement Under § 287

A patentee must mark its patented product in order to collect damages prior to the filing of a claim of infringement where actual notice of infringement was not given. *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 950 F.3d 860, 864 (Fed. Cir, 2020). “If, however, a patentee makes or sells a patented article and fails to mark in accordance with § 287, the patentee cannot collect damages until it either begins providing notice or sues the alleged infringer—the ultimate form of notice—and then only for the period after notification or suit has occurred.” *Id.*

#### II. The Court Should Dismiss Micron’s Counterclaims Because Micron Does Not Plead Sufficient Facts for Those Claims

Each of Micron’s counterclaims should be dismissed for failure to state a claim because Micron does not plead sufficient facts to make those claims rise to the level of plausibility, as required by law.

##### A. Micron Has Failed to Plead Sufficient Facts to State a Claim for Direct Infringement Under § 271(a) That Is Plausible on Its Face

Direct patent infringement under § 271(a) occurs only with respect to acts occurring within the United States. As the Federal Circuit has explained, “§ 271(a) includes express language limiting its scope to domestic acts: ‘[W]hoever without authority makes, uses, offers to sell, or sells any patented invention, *within the United States*, or imports *into the United States* any patented invention during the term of the patent therefore, infringes the patent.’” *Merial Ltd. v. Cipla Ltd.*, 681 F.3d 1283, 1302 (Fed. Cir. 2012) (quoting 35 U.S.C. § 271(a)). But Micron’s counterclaims fail to plead any factual support for its allegations that YMTC or YMTI engage in any of those acts in the United States.

First, Micron does not allege that YMTC or YMTI “makes” the Accused Products in the United States. *See* Counterclaim Complaint, ¶¶ 36, 46, 57, 67, 77. Micron instead alleges the opposite—that the Accused Products are made outside the United States. *Id.*, ¶ 47.

Second, Micron’s counterclaims are devoid of any factual support for its allegations that either YMTC or YMTI sells, offers for sale, or uses the Accused Products in, or imports them into, the United States, thus failing to state a claim for direct infringement that is plausible on its face. Instead, for each counterclaim of infringement, Micron recites the same conclusory allegation that is merely a



formulaic recitation of the cause of action: “[t]he YMTC Entities infringe at least claim 1 of the [asserted] patent under 35 U.S.C. § 271(a), literally and/or under the doctrine of equivalents, by using, offering for sale, selling, and/or importing into the United States, without authorization, the YMTC Accused Storage Products.” *Id.*, ¶¶ 36, 46, 57, 67, 77. But “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice.” *Iqbal*, 556 U.S. at 678. Elsewhere, Micron alleges in only conclusory fashion that YMTC and YMTI “directly and/or indirectly use, sell, offer for sale, import, supply, or otherwise distribute into the United States” the Accused Products, but again pleads no facts to support any one of those allegations. Counterclaim Complaint, ¶¶ 16-18; *see also id.*, ¶ 21. Such conclusory allegations are not accepted as true at the pleading stage, and do not suffice to state a claim for patent infringement. *Twombly*, 550 U.S. at 557; *Garrett*, 2020 WL 5517202, at \*2.

To the extent that Micron attempts to rely, as factual support for its allegations of direct infringement, on (1) its allegation that certain Lexar products contain the Accused Products, and (2) its exhibits that purport to show Bigamart.com and Amazon.com selling those Lexar products in the United States, that argument would lack merit. *See* Counterclaim Complaint, ¶ 21 & Exs. 28-30. None of Lexar, Bigamart, or Amazon is an alter ego of YMTC or YMTI, or is even related to YMTC or YMTI, nor does Micron allege that they are. Moreover, Micron does not allege that those alleged sales were *by* YMTC or YMTI. And the mere existence of an Accused Product in the United States—let alone one that has been integrated into a third party’s product—is not plausible evidence of importation into the United States *by YMTC or YMTI*. *See, e.g., Conformis, Inc. v. Zimmer Biomet Holdings, Inc.*, No. 19-1528-RGA, 2022 WL 1909386, at \*4 (D. Del. June 3, 2022) (“Nowhere does Conformis specifically allege infringing activity by Medacta International taking place in the United States, as required by § 271(a). . . . Because Conformis has failed to specifically allege any infringing activity by Medacta International occurring in the United States, Conformis’s claim of direct infringement by Medacta International is DISMISSED without prejudice.”).

Similarly, Micron’s allegation that YMTC has registered the YMTC trademark in the United States also does not plausibly allege an act of direct patent infringement in the United States. *See*



Counterclaim Complaint, ¶ 21. Registering a trademark is, of course, not a patent-infringing act. Further, Micron does not allege that the products identified in the trademark application are Accused Products, and even if Micron did, Micron does not allege how the submission of a product photograph evidences direct infringement of a patent. The Court is not required to “reach beyond what is actually alleged,” *Conformis*, 2022 WL 1909386, at \*4, and Micron’s strained factual allegations “do not permit the court to infer more than the mere possibility of misconduct.”<sup>3</sup> *Iqbal*, 556 U.S. at 679. Because the allegations of direct infringement by YMTC or YMTI lack any factual support to make those claims plausible, not merely possible, they must be dismissed.

Micron’s allegation of infringement under § 271(a) with respect to the asserted ’996 patent must be dismissed for another reason, too. The ’996 patent claims only methods of forming (i.e., **making**) semiconductor circuitry components and memory cells. Counterclaim Complaint, Ex. 3. A method claim is infringed under § 271(a) only where an unauthorized person performs each method step in the United States. *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1318 (Fed. Cir. 2005) (“We therefore hold that a process cannot be used ‘within’ the United States as required by section 271(a) unless each of the steps is performed within this country.”). But Micron does not allege infringement by way of making the Accused Products, nor could it since the Accused Products are made outside the United States. Counterclaim Complaint, ¶ 47. Micron instead pleads that YMTC and YMTI infringe under § 271(a) by “using, offering for sale, selling, and/or importing into the United States” the Accused Products. *Id.*, ¶ 46. Micron does not, however, plead any factual support—let alone provide any legal support—for how YMTC or YMTI could infringe, under § 271(a), a method of manufacture claim through the sale, offer for sale, use, or importation, of a **product**. *Cf. NTP*, 418 F.3d at 1320 (“[T]he legislative history of section 271(a) indicates Congress’s understanding that method claims could only be directly infringed by use.”). Micron’s claim is not only factually deficient, it is legally broken.

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<sup>3</sup> Moreover, as explained below in Section II.D, Micron has no remedy for any alleged infringement occurring before the service of the Counterclaim Complaint because Micron did not plead compliance with the marking statute, further rendering irrelevant YMTC’s submission of a trademark application four years ago.

**B. Micron Has Failed to Plead Sufficient Facts to State a Claim for Direct Infringement Under § 271(g) That Is Plausible on Its Face**

Presumably because the asserted '996 patent claims only methods of forming circuitry components and memory cells, and Micron admits that the Accused Products are made outside of the United States, Micron also asserts direct infringement of that patent under § 271(g). Counterclaim Complaint, ¶ 47. As with direct infringement under § 271(a), infringement under § 271(g) applies only where the defendant has engaged in the proscribed conduct—using, selling, offering for sale, or importing the allegedly patented product—*in the United States*. *Syngenta*, 944 F.3d at 1364. As the Federal Circuit made clear in *Syngenta*, the infringing act under § 271(g) is the importing, using, offering to sell, or selling in the United States of the patented product—not the making of it outside the United States. *Id.* But, as explained in the previous section, Micron has alleged no facts to support its allegations that *YMTC* or *YMTI* imports, uses, offers to sell, or sells the Accused Products *in the United States*. That products which allegedly incorporate the Accused Products were purchased by Micron from third party websites, does not plausibly show that *YMTC* or *YMTI* imported, used, offered to sell, or sold the Accused Products within the United States. *See supra*, Section II.A; *see also Ziptronix, Inc. v. Omnivision Techs., Inc.*, 71 F. Supp. 3d 1090, 1099 (N.D. Cal. Oct. 21, 2014) (granting summary judgment of no direct infringement under § 271(g) because the Taiwanese defendant delivered the accused components to entities located in Taiwan, and a California corporation arranged for other companies in Asia to combine the components for subsequent importation into the United States).

Micron's factually bare allegations of *YMTC*'s or *YMTI*'s infringement under § 271(g) are insufficient to withstand a motion to dismiss.

**C. Micron Has Failed to Plead Sufficient Facts to State a Claim for Induced Infringement Under § 271(b) That Is Plausible on Its Face**

Micron has also failed to plead a plausible claim for induced infringement under § 271(b). Its induced infringement pleading fails for two independent reasons. First, Micron fails to plead any facts that plausibly show that *YMTC* or *YMTI* had knowledge of the Asserted Patents, or the alleged

1 infringement thereof. Second, Micron fails to plead any facts that plausibly show that YMTC or YMTI  
 2 had the specific intent and did in fact encourage infringement by another. Each of these shortcomings  
 3 independently warrants dismissal. *Lifetime*, 869 F.3d at 1379 (“For an allegation of induced  
 4 infringement to survive a motion to dismiss, a complaint must plead facts plausibly showing that the  
 5 accused infringer ‘specifically intended [another party] to infringe [the patent] and knew that the [other  
 6 party]’s acts constituted infringement.”) (citation omitted).

7 **1. Micron has not plausibly pleaded that YMTC or YMTI had knowledge of**  
 8 **the Asserted Patents or their alleged infringement thereof**

9 To adequately plead inducement, Micron must plead sufficient facts to plausibly demonstrate  
 10 that YMTC and YMTI had knowledge of the Asserted Patents, which is a “crucial element of induced  
 11 infringement.” *Insituform Techs., Inc. v. Cat Contracting, Inc.*, 161 F.3d 688, 695 (Fed. Cir. 1998);  
 12 *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1304 (Fed. Cir. 2006) (“The requirement that the alleged  
 13 infringer knew or should have known his actions would induce actual infringement necessarily  
 14 includes the requirement that he or she knew of the patent.”). Micron does not plead that it provided  
 15 presuit notice of any Asserted Patent to YMTC or YMTI, but instead makes tangential allegations,  
 16 none of which, alone or in combination, plausibly demonstrates that YMTC or YMTI had presuit  
 17 knowledge of the Asserted Patents or the allegedly induced infringement thereof. *See, e.g., Sonos*,  
 18 591 F. Supp. 3d at 648 (“[T]he complaint will generally not be adequate to serve as notice for . . .  
 19 indirect infringement.”).

20 First, Micron alleges that YMTC and YMTI knew of Micron’s patent portfolio and of other  
 21 Micron patents that are not the Asserted Patents—but that is inadequate. “[K]nowledge of a patent  
 22 family or patent portfolio does not equate to knowledge of a specific patent.” *Google LLC v. Sonos*,  
 23 *Inc.*, C20-06754 WHA, 2022 WL 195850, at \*2 (N.D. Cal. Jan. 21, 2022) (citation omitted).  
 24 Specifically, Micron alleges, for each of the Asserted Patents, the YMTC and YMTI “[s]ince before  
 25 the filing of these counterclaims . . . had knowledge of MTI’s patent portfolio with respect to 3D  
 26 NAND technology and that portfolio’s relevance and application to the YMTC Entities’ own  
 27 products.” Counterclaim Complaint, ¶¶ 39, 50, 60, 70, 80. Elsewhere in its counterclaims, Micron  
 28

1 alleges that YMTC and YMTI knew that Micron has patents in the 3D NAND space and that YMTC's  
2 own patents cite to certain unasserted Micron patents, but *not* to the Asserted Patents. *Id.*, ¶ 31. These  
3 allegations suggest nothing more than YMTC and YMTI having knowledge of Micron's patent  
4 portfolio generally, which is insufficient to state a claim. *Google*, 2022 WL 195850, at \*2. That none  
5 of YMTC's patents cite the Asserted Patents but instead cite only other patents does not plausibly  
6 suggest that YMTC or YMTI knew of the Asserted Patents—it suggests the opposite: that it did not.

7 Second, as to the specific Asserted Patents, Micron alleges in only conclusory fashion that  
8 YMTC and YMTI “have direct knowledge of” those patents solely on account of “the large number  
9 of former Micron NAND engineers now working at the YMTC Entities.” Counterclaim Complaint, ¶  
10 32. But Micron alleges no facts that would plausibly suggest that those engineers knew of the Asserted  
11 Patents. “[A] district court is not required to accept as true ‘allegations that are merely conclusory,  
12 unwarranted deductions of fact, or unreasonable inferences.’” *Garrett*, 2020 WL 5517202, at \*2  
13 (quoting *In re Gilead*, 536 F.3d at 1055). Moreover, Micron avers that it filed “dozens” of patents on  
14 3D NAND before it even launched its first product back in 2015, Counterclaim Complaint, ¶ 11, and  
15 presumably has filed many more patents since. That Micron has at least “dozens” of patents on 3D  
16 NAND technology further demonstrates that it would be an “unwarranted deduction[] of fact” to  
17 assume that the alleged ex-Micron engineers even knew of the Asserted Patents, let alone that they  
18 communicated that knowledge to YMTC or YMTI. But even if Micron's conclusory allegations did  
19 plausibly suggest knowledge of the Asserted Patents, Micron still does not allege—in even conclusory  
20 fashion—that YMTC or YMTI knew of the alleged infringement of those patents. Accordingly,  
21 Micron has failed to state a claim for induced infringement. *Lifetime*, 869 F.3d at 1379 (“For an  
22 allegation of induced infringement to survive a motion to dismiss, a complaint must plead facts  
23 plausibly showing that the accused infringer ‘. . . knew that the [other party]’s acts constituted  
24 infringement.’”) (citation omitted).

1                   **2.       Micron has not plausibly alleged that YMTC or YMTI has induced**  
 2                   **another to infringe**

3           A second, independent reason why Micron’s counterclaims for inducement must be dismissed  
 4 is that Micron fails to plead any facts to plausibly establish that YMTC or YMTI has actually induced  
 5 another to infringe. Inducement requires both “an affirmative act” to encourage another party to  
 6 infringe, *Power Integrations*, 843 F.3d at 1332, and the specific intent to cause infringement, *Lifetime*  
 7 *Indus.*, 869 F.3d at 1379 (“For an allegation of induced infringement to survive a motion to dismiss, a  
 8 complaint must plead facts plausibly showing that the accused infringer ‘specifically intended [another  
 9 party] to infringe [the patent]. . . .’”) (citation omitted). Micron has not sufficiently pleaded either.

10          Micron’s allegations throughout in its counterclaims, taken individually or as a collection, fail  
 11 to plausibly suggest that YMTC or YMTI took affirmative acts or specifically intended others to make,  
 12 use, sell, offer for sale, or import the Accused Products *in the United States*. Micron alleges that  
 13 YMTC and YMTI “actively encourage others” to infringe. Counterclaim Complaint, ¶ 22. In support  
 14 of that conclusory allegation, Micron cites only a YMTC website that Micron alleges “advertises” the  
 15 Accused Products. *Id.* But Micron fails to identify any facet of that website that purports to encourage  
 16 customers to make, use, sell, offer to sell, or import the Accused Products in the United States—in  
 17 other words, to allegedly infringe—because none of it does.<sup>4</sup> Micron’s allegations do not rise to the  
 18 level of plausibility. Moreover, mere product marketing does not demonstrate the specific intent  
 19 required for induced infringement, even at the pleading stage. *Masimo Corp. v. Sotera Wireless*, No.  
 20 19-CV-01100-BAS-NLS, 2020 WL 2306587, at \*10 (S.D. Cal. May 8, 2020) (holding that plaintiff’s  
 21 “contention that [defendant] marketed and sold an allegedly infringing product cannot, standing alone,

22  
 23          <sup>4</sup> Elsewhere, Micron alleges the unremarkable fact that the “YMTC Entities make their website...  
 24 available in the English language.” Counterclaim Complaint, ¶ 23. An allegation that they make  
 25 their website available in the world’s most widely spoken language is not suggestive of a specific  
 26 intent to induce customers to use the Accused Product in the United States—just one of the world’s  
 27 English-speaking countries. And normal commercial behavior does not plausibly suggest an intent  
 28 to induce infringement. *Compare Twombly*, 550 U.S. at 557 (allegations of commercial behavior  
 that are merely “consistent with” an illegal agreement in restraint of trade, do not plausibly suggest  
 one, and are insufficient to withstand dismissal).

1 state a claim for active inducement without affirmatively alleging a defendant’s intent to encourage  
2 infringement” and collecting cases).

3 Elsewhere, in each of its counterclaims of patent infringement, Micron recites identical  
4 allegations concerning inducement that are conclusory and devoid of any factual matter. But “a  
5 complaint **must** contain sufficient factual matter” to survive a motion to dismiss. *Iqbal*, 556 U.S. at  
6 678 (emphasis added). In particular, Micron alleges that “the YMTC Entities encourage, train,  
7 instruct, and provide support and technical assistance to others to directly infringe the [asserted] patent  
8 by contracting with, encouraging, and instructing third parties, including equipment and design  
9 manufacturers, device manufacturers, distributors, customers, and other third parties to use, sell, offer  
10 for sale, and/or import into the United States, the YMTC Accused Storage Products and products that  
11 incorporate the YMTC Accused Storage Products.” Counterclaim Complaint, ¶¶ 40, 51, 61, 71, 81.  
12 That is a conclusory and factually bereft allegation that is entitled to no weight on a motion to dismiss.  
13 *See Iqbal*, 556 U.S. at 681 (“It is the conclusory nature of [plaintiff’s] allegations, rather than their  
14 extravagantly fanciful nature, that disentitles them to the presumption of truth.”).

15 The following sentence in the counterclaims fares no better, as Micron alleges the following:  
16 “For instance, the YMTC Entities publish and provide technical materials, product specifications, and  
17 promotional literature for the YMTC Accused Storage Products that instruct and encourage the YMTC  
18 Entities’ customers and other third parties to integrate the YMTC Accused Storage Products into  
19 products made, used, sold, offered for sale, and/or imported into the United States, and work with  
20 customers and potential customers to design their products using the YMTC Accused Storage Products  
21 with knowledge that those products will be used and sold in the United States.” Counterclaim  
22 Complaint, ¶¶ 40, 51, 61, 71, 81. Again, this allegation is conclusory and devoid of any factual matter.  
23 For example, Micron does not identify any alleged “technical materials, product specifications, [or]  
24 promotional literature,” or aver how those unidentified materials instruct or encourage YMTC’s or  
25 YMTI’s alleged customers to make, use, sell, offer to sell, or import the Accused Products—let alone  
26 encourage such alleged customers to undertake those acts within the United States, as would be  
27 required to infringe. *Cf. Warner–Lambert Co. v. Apotex Corp.*, 316 F.3d 1348, 1364 (Fed. Cir. 2003)  
28

1 (“[M]ere knowledge of possible infringement by others does not amount to inducement; [rather,]  
 2 specific intent and action to induce infringement must be proven.”) (citation omitted); *Skyworks Sols.,*  
 3 *Inc. v. Kinetic Techs., Inc.*, No. 14-cv-10-SI, 2015 WL 881670, at \*9 (N.D. Cal. Mar. 2, 2015)  
 4 (granting summary judgment of no induced infringement by California corporation where plaintiff  
 5 “has not provided evidence that [certain] datasheets induced Samsung or other customers to directly  
 6 infringe by importing phones containing the accused parts into the United States or offering to sell  
 7 phones containing accused parts to customers in the United States” and where “[t]he evidence that  
 8 [plaintiff] cites fails to support even an inference that [U.S.-based defendant] worked for months with  
 9 Samsung’s U.S. design groups to incorporate its infringing parts into Samsung phones designed  
 10 specifically for the U.S. market”). If YMTC or YMTI “technical materials, product specifications,  
 11 [or] promotional literature” existed that encouraged customers to use, import, sell, or offer to sell the  
 12 Accused Products in the United States, presumably Micron would have cited them.

13       Next, Micron’s allegation that YMTC and YMTI “specifically intended for their customers  
 14 and end-users to use the YMTC Accused Storage Products in such applications and provide  
 15 instructions and encouragement for the customers and end-users to do so,” is defective for at least two  
 16 reasons and does not state a claim for relief. *See* Counterclaim Complaint, ¶ 22. First, that allegation  
 17 is bereft of any factual content; it is merely conclusory. And the “conclusory claim that [YMTC and  
 18 YMTI] knew and intended the products to be used in an infringing manner does not state a claim that  
 19 [they] knew [their customers and end-users] acts constituted infringement and specifically intended to  
 20 encourage those acts.” *Masimo*, 2020 WL 2306587, at \*9. Second, an allegation that YMTC and  
 21 YMTI encourage customers to use the Accused Products generally does not plausibly suggest an intent  
 22 to encourage customers or end-users use the Accused Products in the United States specifically. At  
 23 most, such allegation is merely “consistent with” an intent to encourage use in the United States—but  
 24 that is insufficient to state a claim. *Twombly*, 550 U.S. at 557 (“The need at the pleading stage for  
 25 allegations plausibly suggesting (*not merely consistent with*) [an illegal] agreement reflects the  
 26 threshold requirement of Rule 8(a)(2) that the ‘plain statement’ possess enough heft to ‘sho[w] that  
 27 the pleader is entitled to relief.’”) (emphasis added).



1        *Twombly* is instructive because there, the Supreme Court held that to state a claim under § 1  
 2 of the Sherman Act, it was inadequate for a complaint to contain mere allegations of parallel conduct,  
 3 without some allegations that raise a suggestion of a preceding agreement. *Id.* at 556-557. That is  
 4 because “parallel conduct . . . could just as well be independent action,” and without “further  
 5 circumstance pointing to a meeting of the minds, an account of a defendant’s commercial efforts stays  
 6 in neutral territory.” *Id.* at 557 (“An allegation of parallel conduct is thus much like a naked assertion  
 7 of conspiracy in a § 1 complaint: it gets the complaint close to stating a claim, but without some further  
 8 factual enhancement it stops short of the line between possibility and plausibility of ‘entitle[ment] to  
 9 relief.’”). *Id.* Micron’s description of YMTC’s and YMTI’s commercial efforts, *i.e.*, their alleged  
 10 encouragement of others to use the Accused Products, likewise “stays in neutral territory,” as that  
 11 description lacks any further allegation that plausibly suggests specific intent to induce infringement.

12        That YMTC and YMTI allegedly consider the United States an important market does not fill  
 13 the void in Micron’s pleading. *See* Counterclaim Complaint, ¶ 29. For example, in *Viavi*, it was  
 14 undisputed that the United States was Viavi’s customer’s biggest market—yet that did not show intent  
 15 to induce as a matter of law. *Viavi*, 2003 WL 6795417, at \*6. In comparison, Micron does not even  
 16 allege that the United States is the biggest market for YMTC or YMTI (or any of their customers).

17        Similarly, Micron’s allegation that YMTC’s products are “designed to comply with safety  
 18 standards required for sale or import into the U.S. market,” Counterclaim Complaint, ¶ 23, is  
 19 insufficient to show intent to induce infringement (and, regardless, Micron’s allegation is merely  
 20 conclusory, as it identifies no such standards). “The fact that the products are capable of infringing  
 21 because they meet certain specifications does not necessarily show requisite intent to induce.” *Viavi*,  
 22 2023 WL 6795417, at \*6 (citing *Skyworks Sols.*, 2015 WL 881670, at \*8–10) and *Lucent Techs., Inc.*  
 23 *v. Gateway, Inc.*, 580 F.3d 1301, 1322 (Fed. Cir. 2009)). Tellingly, Micron does not allege what those  
 24 purported safety standards are, let alone whether they are unique to the United States, such that  
 25 compliance with them could be purposeful, or instead are the same as or similar to standards required  
 26 in other global markets where YMTC products may be sold.



Finally, Micron’s allegation that YMTC and YMTI know that the Accused Products (and products incorporating them) are sold in the United States is, like the rest of its allegations, woefully deficient. *See* Counterclaim Complaint, ¶ 24. In support of that allegation of knowledge, Micron relies only on the alleged presence in the United States of two individuals it alleges are YMTC employees. *Id.*, ¶¶ 24-27. First, Micron points to Mr. David Duffin, who is employed by YMTI but who Micron incorrectly alleges, without evidentiary basis, is employed by YMTC. *Id.*, ¶¶ 24-27. And none of Micron’s allegations about Mr. Duffin plausibly suggest that YMTC or YMTI know that the Accused Products are being sold in the United States. Micron alleges that Mr. Duffin “advertises that he is ‘used to regularly and directly interacting with customers.’” *Id.*, ¶ 24 (citing Ex. 31). Not only does that statement come from Mr. Duffin’s summary of his experience in the semiconductor industry generally, which spans many companies, and is not a statement about his particular experience at YMTI, *see id.*, Ex. 31, but a generic statement of interacting with customers does not plausibly suggest that YMTC or YMTI know where customers end up selling goods that incorporate the Accused Products, particularly where YMTC allegedly services multiple countries, *id.* ¶ 29. *See, e.g., Viavi*, 2023 WL 6795417, at \*5 (finding no inducement as a matter of law where defendant did not know where its accused lenses “end up after they are sold to the module integrators”). It is also notable that Micron does not allege that YMTC or YMTI in fact have any U.S. customers.<sup>5</sup>

Second, Micron points to Mr. Daesik Song, a former Micron employee now at YMTI, but Micron’s allegations provide no plausible support for Mr. Song having knowledge about purported sales of goods incorporating the Accused Products in the United States. Counterclaim Complaint, ¶ 27. That YMTI employs a former Micron engineer does not plausibly suggest an intent to induce infringement of the Asserted Patents.

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<sup>5</sup> Micron also alleges that Mr. Duffin had a technical role at YMTC from 2016-2019, Counterclaim Complaint, ¶ 25, but it is unclear how that has any bearing on YMTC’s or YMTI’s alleged knowledge today. As discussed above, Micron does not plausibly allege that YMTC or YMTI had pre-filing knowledge of the Asserted Patents or the alleged infringement thereof, and hence there could not have been any induced infringement by YMTC or YMTI so many years ago. Nor does Micron allege any facts that would suggest that any purported knowledge from 2019 remains valid and not stale five years later.

1 Because Micron insufficiently pleads actual inducement, Micron's claims of induced  
2 infringement must be dismissed.

3 **D. Even if Micron Had Stated Some Plausible Claim for Infringement, Because It**  
4 **Has Not Pleaded Compliance with The Marking Statute, Its Has Failed to State**  
5 **a Claim for Infringement Before the Filing of Its Counterclaims**

6 Even if the Court were to determine that Micron had stated some claim for relief, at minimum,  
7 the Court should dismiss any claim for infringement before the filing of Micron's counterclaims for  
8 at least the '737 Patent, the '214 Patent, the '903 Patent, and the '974 Patent. Because Micron has not  
9 pleaded compliance with the marking statute for those patents, it cannot recover any damages for  
10 alleged infringement of them for the period prior to service of its Counterclaim Complaint.<sup>6</sup>

11 Where "a patentee makes or sells a patented article and fails to mark in accordance with § 287,  
12 the patentee cannot collect damages until it either begins providing notice or sues the alleged  
13 infringer—the ultimate form of notice—and then only for the period after notification or suit has  
14 occurred." *Arctic Cat*, 950 F.3d at 864; *Express Mobile, Inc. v. Liquid Web, LLC*, No. 1:18-cv-01177-  
15 RGA, 2019 WL 1596999, at \*2 (D. Del. Apr. 15, 2019) (granting a motion to dismiss for failure to  
16 plead compliance with the marking statute) ("35 U.S.C. § 287(a) requires that a patentee who makes  
17 or sells a patented article mark the articles to recover past damages."). Micron did not provide presuit  
18 notice of alleged infringement to YMTC or YMTI, nor does Micron allege that it did. Accordingly,  
19 only service of the Counterclaim Complaint served as requisite notice. "There is no dispute that the  
20 patentee bears the burden of pleading and proving he complied with § 287(a)." *Arctic Cat Inc. v.*  
21 *Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1367 (Fed. Cir. 2017); *see also Express Mobile*,  
22 2019 WL 1596999, at \*2 ("It is the patentee's burden to plead compliance with § 287(a).") (citation  
23 omitted). Micron has not pleaded such compliance. Therefore, Micron cannot collect damages prior  
24 to the filing of the Counterclaim Complaint for at least the '737 Patent, the '214 Patent, the '903 Patent,  
25 or the '974 Patent. As a result, it has failed to state a claim for pre-filing infringement for at least those

26 \_\_\_\_\_  
27 <sup>6</sup> The '996 patent contains only method claims, and thus the notice provisions of § 287 do not apply.  
28 *See Crown Pack. Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308, 1316 (Fed. Cir. 2009).

patents. *See, e.g., Ortiz & Assocs. Consulting v. Vizio, Inc.*, No. 3:23-CV-00791, 2023 WL 7184042, at \*3 (N.D. Tex. Nov. 1, 2023) (holding that as to pre-suit alleged infringement, because plaintiff “failed to state a claim for pre-suit damages, [plaintiff] has not stated a claim that is plausible on its face”).

**E. Because It Has Failed to State a Claim for Infringement, Micron Also Has Failed to State a Claim for Willful Infringement**

Micron alleges in conclusory fashion that YMTC and YMTI have willfully infringed the Asserted Patents. Counterclaim Complaint, ¶¶ 41, 52, 62, 72, 82. But for the reasons articulated above, Micron has failed to state a claim for direct or indirect patent infringement. Without a claim for infringement, there can be no claim for willful infringement, and so Micron’s claims willful infringement must be dismissed, too.

**CONCLUSION**

For the foregoing reasons, YMTC and YMTI respectfully request that the Court dismiss Micron’s counterclaims.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that this document is being served upon counsel of record for Defendant's  
and Counterclaim Plaintiff on March 12, 2024, via electronic service.

/s/ Andrew T. Radsch

Andrew T. Radsch